Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAFAR NABKEL, KAREN SIEGEL-JACOBS,
HARVEY J. BENSON, EDWARD A. YOUNGS,
DONALD E. GILLESPIE, MARK S. MAIZE,
and MARK W. HARDISON

Appeal No. 2004-0961
Application No. 09/785,863

ON BRIEF

Before OWENS, RUGGIERO, and BARRY, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from the final rejection of claims 1-5, 8-16, 19-27 and 30-38, which are all of the claims pending in the application.

THE INVENTION

The appellants claim a method and system for providing preselected information services to a telephone subscriber.

Claim 1, which claims the method, is illustrative:

> 1. In a communication network comprising a plurality of subscriber telephone lines, each coupled to an associated telephoning switching facility, each subscriber telephone line having at least one directory number and an associated subscriber profile including selected information services, a method for providing information services to a subscriber, comprising:
> detecting an off-hook condition at a subscriber telephone line;
> determining the information services selected by the subscriber by correlating the subscriber directory number with the selected information services in the subscriber's profile in accordance with predetermined criteria, wherein the predetermined criteria includes the time, date, or day of week; and,
> in response to the off-hook condition, generating a message corresponding to the selected information services for receipt by the subscriber.

THE REFERENCES

McLeod et al. (McLeod)	5,222,120	Jun. 22, 1993
Kung et al. (Kung)	6,373,817	Apr. 16, 2002 (filed Dec. 30, 1999)

THE REJECTION

Claims 1-5, 8-16, 19-27 and 30-38 stand rejected under 35 U.S.C. § 103 as being unpatentable over McLeod in view of Kung.

OPINION

We affirm the aforementioned rejection.

The appellants indicate that the claims all stand or fall together (brief, page 4). We therefore limit our discussion to

one claim, i.e., claim 1. *See In re Ochiai*, 71 F.3d 1565, 1566 n.2, 37 USPQ2d 1127, 1129 n.2 (Fed. Cir. 1995); 37 CFR § 1.192(c)(7)(1997).

Kung discloses a method for providing multi-network access and routing among a packet-switched network and a circuit-switched network to chase called parties (col. 1, lines 12-15; col. 2, lines 22-23). Such a system necessarily comprises a communication network including a plurality of subscriber telephone lines, each coupled to an associated telephoning switching facility, each subscriber telephone line having at least one directory number as required by the appellants' claim 1.

Kung discloses that an announcement server may detect when a phone or other device has been taken off-hook and then play an advertisement or other announcement to the user (col. 10, lines 13-15), and that the user may sign up for an advertising plan whereby phone rates are reduced in return for advertising revenue generated by the advertisements (col. 10, lines 15-20). Such an advertising plan is among the appellants' information services selected by the subscriber (specification, page 7, line 26 - page 8, line 2). That disclosure, together with Kung's disclosure of keeping a user profile (col. 10, lines 18-20), would have fairly suggested, to one of ordinary skill in the art,

determining whether the user is to receive advertisements, when the phone is taken off-hook, by correlating the user's directory number with an indication in the user's profile that the advertising plan has been selected. Kung's disclosure that a call manager may request that certain announcements be played a specified number of times (col. 10, lines 27-30) would have fairly suggested, to one of ordinary skill in the art, correlating the user's directory number with the advertising plan in accordance with a predetermined time criterion, i.e., the timing of those advertisements. Thus, Kung would have fairly suggested, to one of ordinary skill in the art, the detecting, determining and generating steps in the appellants' claim 1.

The appellants argue that Kung discloses playing random advertisements (brief, pages 5 and 7). Kung does not disclose that the advertisements are played randomly. Kung's disclosure of playing announcements a specified number of times (col. 10, lines 27-30) would have fairly suggested, to one of ordinary skill in the art, playing advertisements at a specified number of preselected times.

The appellants argue that Kung would not have suggested delivery of information services according to a schedule and frequency preestablished by a subscriber (brief, page 5; reply brief, page 3). The appellants' claim 1 requires that the

subscriber directory number is correlated with the information services selected by the subscriber in accordance with a predetermined time, date or day of the week criterion, but does not require that the predetermined criterion is selected by the subscriber. Thus, the claim encompasses correlating a subscriber directory number with Kung's advertising plan in accordance with a predetermined time criterion which is the timing of Kung's advertisements that are to be played a specified number of times (col. 10, lines 28-30).

We therefore conclude that the invention claimed in the appellants' claim 1 would have been obvious to one of ordinary skill in the art over the applied prior art.[1] Accordingly, we affirm the rejection of that claim and claims 2-5, 8-16, 19-27 and 30-38 that stand or fall therewith.

No period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

[1] A discussion of McLeod is not necessary to our decision.

TERRY J. OWENS Administrative Patent Judge	)
JOSEPH F. RUGGIERO Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
LANCE LEONARD BARRY Administrative Patent Judge	)

TJO/sld

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHT FLOOR
SAN FRANCISCO, CA 94111-3834